

## **REMARKS**

Claims 1-11 remain in the application for further prosecution.

### **Improper Use of a Final Rejection**

As an initial matter, it is the Applicants' belief that the final rejection was in error. Claim 1 was amended to state that the "video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game." Such a limitation was not included in any of the prior claims, and this is the first time such a limitation is being addressed by the Examiner. MPEP §706.07(b).

Also, new claim 11 was added in the previous response. Independent claim 11 includes a limitation that was not included in prior claims ("each of said second indicia being illuminated independently of other second indicia.") Because this is the first time this limitation is being addressed by the Examiner, it is the Applicants' belief that the finality of the rejection is improper.

Therefore, for at least these reasons, it is respectfully requested that the finality of this office action be withdrawn.

### **35 U.S.C. § 103(a) Rejections of Claim 1**

Independent claim 1 includes the limitation that the "video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game." The claim also includes the limitation of a unitary touch screen that overlaps both the video portion and the non-video portion.

The Examiner states that various features of the claim can be found in U.S. Pat. No. 5,769,716, to Saffari et al. (Saffari) in view of European Patent No. EP0789338 to Bruzzese

(Bruzzese). As stated previously, it is the Applicants' belief that the prior art does not disclose all of the features of independent claim 1. The combination of Saffari and Bruzzese fails to disclose "a unitary touch screen overlapping both said video portion and said non-video portion," wherein the video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game.

Saffari discloses the use of a touch screen panel that overlays a video screen. The Examiner **admits** that Saffari is silent regarding the incorporation of a unitary touch screen across both a video portion and a non-video portion. Bruzzese discloses a touch screen 34 and a graphical display 38. The touch screen 34 of Bruzzese **does not overlay a video display that displays a plurality of symbols indicating a randomly selected outcome of the game, as required by claim 1.** The graphical display 38 provides the player with game information, credits, and/or advertisements. Bruzzese, col. 3, ll. 27-31. Quite differently, the symbols in Bruzzese for indicating the randomly selected outcome are the mechanical reels located away from the graphical display 38. In order to prove a *prima facie* case of obviousness, three criteria must be met: there must be some suggestion or motivation to modify the reference or combine the teachings; there must be a reasonable expectation of success; and the prior art reference must teach or suggest all the claim limitations. The suggestion to combine the prior art must be found in the prior art and not be based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488. The Examiner has failed to provide a motivation to combine and that the combination discloses **all** of the elements of the claims.

First, the Examiner has failed to provide a proper motivation to combine the two references. It is the Applicants' opinion that the Examiner is using the specification as a

roadmap for finding the prior art to reject the claims. The Examiner is not considering the claimed invention as a whole. Claim 1 requires that there be **both** player-selectable first indicia that is selectable via the unitary touch screen **and** permanent player-selectable second indicia on the non-video portion that is selectable via the touch screen. There is no suggestion in either reference that it would be desirable to have both types of indicia. Saffari, in fact, discloses explicitly, having **either** touch screen buttons **or** permanent buttons.

Also, the statement in Bruzzese that the Examiner relies upon for the proposed modification actually contradicts the purpose of Bruzzese. As stated by the Examiner, one of the goals of Bruzzese is to reduce manufacturing cost. Reducing the cost of manufacture would best be achieved by utilizing **all** buttons on the video portion, not some player-selectable indicia on the video portion and some permanent player-selectable indicia on the non-video portion.

Even if there were a suggestion to combine the references (and there is not), the Examiner has still failed to prove a *prima facie* case of obviousness because the combination of Saffari and Bruzzese fails to disclose all of the limitations of claim 1. Claim 1 requires “a unitary touch screen overlapping both said video portion and said non-video portion.” As recited previously in claim 1, the video portion “displays a plurality of symbols indicating a randomly selected outcome of a wagering game.” The combination of Saffari and Bruzzese does not disclose such a limitation. Neither Saffari nor Bruzzese disclose utilizing a unitary touch screen that overlaps both video and non-video portions, where the video portion displays a plurality of symbols indicating a randomly selected outcome. The combination of Saffari and Bruzzese would result in a unitary touch screen that overlaps a video portion that, as disclosed in Bruzzese, does not include the randomly selected outcome.

Therefore, independent claim 1 and its dependents are believed to be allowable over the combination of Saffari and Bruzzese.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari in view of Bruzzese, and in further view of U.S. Patent No. 5,033,744, (Bridgeman et al.). Claim 4 is dependent from claim 1 and includes the limitation of player-selectable first indicia on the video portion and permanent player-selectable second indicia on the non-video portion. As stated above in reference to claim 1, the combination of Saffari and Bruzzese does not disclose or suggest such a feature. It is also the Applicants' belief that Bridgeman does not disclose or suggest such a feature. Therefore, for at least these reasons, claim 10 is also believed to be allowable. Therefore, for at least the reasons stated above, claim 4 is also believed to be allowable.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari in view of Bruzzese as applied to claims 1 and 3 above in further view of U.S. Patent No. 6,089,976 to Shneider et al. (Schneider). Claim 10 is dependent upon claim 1. Therefore, claim 10 includes the limitation of player-selectable first indicia on the video portion and permanent player-selectable second indicia on the non-video portion. As stated above in reference to claim 1, the combination of Saffari and Bruzzese does not disclose or suggest such a feature. It is also the Applicants' belief that Schneider does not disclose or suggest such a feature. Therefore, for at least these reasons, claim 10 is also believed to be allowable.

### **35 U.S.C. § 103(a) Rejections of Claim 11**

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saffari in view of Bruzzese, and in further view of U.S. Patent No. 5,033,744, (Bridgeman et al.). Claim 11 is an

independent claim that also includes the limitations that the video portion displays a plurality of symbols indicating a randomly selected outcome of a wagering game that a unitary touch screen that overlaps both the video portion and the non-video portion, the video portion. The non-video portion includes permanent player-selectable second indicia that are selectable via said unitary touch screen. Claim 11 also includes the limitation of “each of said second indicia being illuminated independently of other second indicia.”

In the Office Action, the Examiner stated that it is unclear how the Applicants believe that the illumination device of Bridgeman is a singular device. First, it is the Applicants’ belief that Bridgeman does not disclose a plurality of light circuits as alleged by the Examiner. January 10, 2006 Office Action, page. 5. FIG. 2 illustrates only a single “light circuit 238” – not “light circuits”. If there were light circuits 238 (plural), then there should have been multiple boxes showing the different drive circuits or multiple arrows to the light circuits box 238. Also, in the listing of the drawing reference numerals, 238 refers to a single light circuit, and not a plurality of light circuits. Bridgeman, col. 4, l. 11.

Second, even if the language in the specification of Bridgeman cited by the Examiner were correct, and Bridgeman had multiple light circuits 238 (in contradiction to FIG. 2 and the specification at col. 4, l. 11), this language does **not** disclose “second indicia that can be illuminated independently of other second indicia.” Bridgeman states that “[a] drive circuit 226 controls the light circuits 238 that light up the buttons to indicate the key activators 236 are ready to accept input data.” Bridgeman, col. 5, l. 68 – col. 6, l. 2. There is no indication in this passage (or elsewhere in Bridgeman) that the each of the buttons can be lit independently. This passage simply indicates that all of the buttons are lit up at one time when the machine is ready for input.

The drive circuit 226 is what determines whether the light circuit 238 is activated, and there is only a single drive circuit 226. The single drive circuit 226 either activates all of the lights or it deactivates all of the lights. Once the drive circuit 226 goes on, then all of the lights are lit.

In addition to the above-stated reason, it is the Applicants' belief that there is no suggestion or motivation in either Saffari or Bruzzese to combine the references to create a gaming machine that utilizes player-selectable first indicia on the video portion and permanent player-selectable second indicia on the non-video portion. Bridgeman also does not disclose such a feature or provide any suggestion for such a feature. Therefore, for at least the reasons stated above, claim 11 is also believed to be allowable.

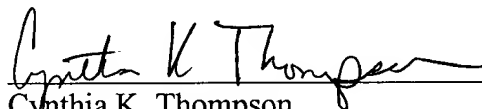
### **Conclusion**

It is the Applicant's belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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